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OFFICE OF PETITIONS

In re Application of :
Hiroyuki Hagano et al. :
Application No. 10/622,776 : DECISION ON SECOND RENEWED
Filed: July 21, 2003 : PETITION PURSUANT TO
Attorney Docket No. 26D-010 : 37 C.F.R. § 1.181(A) AND
Title: RESIN MEMBER AND METHOD : PETITION PURSUANT TO 37
OF MANUFACTURING THE SAME : C.F.R. § 1.137(B)

This is a decision on the second renewed petition pursuant to 37 C.F.R. § 1.181(a), filed November 13, 2007, to withdraw the holding of abandonment, as well as the concurrently filed petition pursuant to 37 C.F.R. § 1.137(b)¹.

¹ A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

BACKGROUND AND PROCEDURAL HISTORY

The above-identified application became abandoned for failure to submit the issue and publication fees in a timely manner in reply to the Notice of Allowance and Issue Fee Due, mailed January 24, 2007, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting issue or publication fees². Accordingly, the above-identified application became abandoned on April 25, 2007. A Notice of Abandonment was mailed on May 23, 2007.

An original petition was filed on June 13, 2007, and was dismissed via the mailing of a decision on September 12, 2007 for failure to establish non-receipt of the Office communication. A renewed petition was filed on September 20, 2007, and was dismissed via the mailing of a decision on October 26, 2007.

RELEVANT PORTION OF THE MPEP

MPEP §711.03(c)(I)(A) sets forth, *in toto*:

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of Delgar, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement (emphasis added). For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than

² See MPEP § 710.02(e).

that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See Lorenz v. Finkl, 333 F.2d 885, 889-90, 142 USPQ 2d, 29-30 (CCPA 1964); Krahn v. Commissioner, 15 USPQ2d 1823, 1824 (E.D. Va 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

ANALYSIS

With the original petition, Petitioner included a statement that a thorough search of the file jacket and docket records was conducted, and a docket record that was not legible.

With the renewed petition, Petitioner submitted a legible copy of the docket record that did not contain all received Office communications.

With this second renewed petition, Petitioner has submitted additional screenshots that comprise the docket record, along with an explanation of how this docket record operates.

Considering the facts and circumstances of the delay at issue, as set forth on petition, it is concluded that Petitioner has met his burden of establishing that the mailing was not received.

Accordingly, the petition under 37 C.F.R. § 1.181(a) is **GRANTED**. The holding of abandonment is **WITHDRAWN**.

Along with this second renewed petition, Petitioner has submitted the issue and publication fees. The concurrently filed petition pursuant to 37 C.F.R. § 1.137(b) is **DISMISSED AS MOOT**. The fee that is associated with the filing of the same has not been charged to Petitioner's Deposit Account.

The Office of Patent Publication will be notified of this decision so that the present application can be processed into a patent. Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225³. All other

³ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. §1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

inquiries concerning the status of the application should be directed to the Office of Patent Publication at 571-272-4200.



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